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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/752,733

01/07/2004

Norman H. Margolus

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06/05/2006

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EXAMINER

EHICHIOYA, FRED I

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/752,733	Applicant(s) MARGOLUS, NORMAN H.	
	Examiner Fred I. Ehichioya	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 111-113 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 111 - 113 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Examiner contacted with applicant's representative (Maureen Christiano: 617-521-7090) to check on the status of remaining claim 11 – 113 that have “canceled” instead of “Original”. Maureen confirmed that the status (canceled) on claims 111 - 113 is erroneous.
2. Claims 111 –113 are pending in this Office Action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 111 – 113 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,659,626 issued to Ort et al (Hereinafter “Ort”) in view of USPN 6,801,999 issued to Venkatesan et al (Hereinafter “Venkatesan”).

Regarding claim 111, Ort teaches a method by which a client connected to a data repository over a lower speed network connection may provide higher speed access to a data item for application processing than is possible over the relatively low speed connection to the network, the method comprising:

determining a digital fingerprint of the data item (column 6, lines 25 – 30);

testing for whether the data item is already stored in a repository by comparing the digital fingerprint of the data item to digital fingerprints of data items already in the repository (column 6, lines 36 – 44);

only if the data item is not already in the repository, transferring the data item over the lower speed connection from the client to the repository (column 28, lines 41 – 49);

executing an application on the application server to process the data item stored on the data repository (column 6, lines 45 – 48); and

returning at least some of the processed data to the client across the lower speed connection (column 6, lines 31 b- 36).

Ort does not explicitly teach expiration time as claimed.

Venkatesan teaches assigning an expiration time to the data item, before which time deletion is prohibited (column 17, lines 32 – 40); and

making a higher speed connection between an application server and the data repository (column 17, lines 9 – 19).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Venkatesan's teaching of "expiration time" would have allowed Ort's system to monitor when individual fingerprint is accessed. The motivation is that the expiration time safeguard privacy of user data and prevent an authorized use of the fingerprint stored in the database.

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Regarding claim 112, Venkatesan teaches rules governing expiration and deletion are distributed among a plurality of storage sites (column 25, lines 17 – m21).

Regarding claim 113, Venkatesan teaches the expiration time assigned to the data item depends upon expiration times assigned by the client programs (column 35, lines 5 – 14).

Prior Art of Record

4. The Prior Art made of record but not relied upon are pertinent to the prosecution of this application:

- a. **USPN 6,618,751** – Challenger et al.
- b. **USPN 5,933,515** – Pu et al
- c. **USPN 6,963,659** – Tumey et al.
- d. **USPN 6,269,382** – Cabrera et al

Conclusion


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fred I. Ehichioya
Patent Examiner
Art Unit 2162

May 29, 2006


SHAHID ALAM
PRIMARY EXAMINER